

REMARKS

The presently claimed invention features methods for determining whether a test compound is a candidate modulator of drug resistance of a cell. Certain claimed methods entail assessing the effect of a test compound on expression of MDA-9. Other claimed methods entail determining whether a test compound binds to MDA-9 protein. Some claimed methods entail testing a candidate modulator in a non-human mammal.

Rejections Under 35 U.S.C. §112, second paragraph

The Examiner rejected claim 22 for reciting MDA-0 rather than MDA-9. Applicant has amended claim 22 to recite MDA-9, obviating this rejection.

Rejections Under 35 U.S.C. §102(e)

The Examiner rejected claims 1-3, 21 and 22 as allegedly anticipated by Fischer (U.S. Patent 6,071,679) as evidenced by Serrone et al. (*Melanoma Research* 9:51, 1999). According to the Examiner, the claimed methods are inherent in the method described by Fisher. Applicant respectfully traverses this rejection.

“Anticipation requires identity of the claimed process and a process of the prior art; the process, including each step thereof, must have been described or embodied in the, either expressly or inherently in a single reference.” *Glaverbel Societe Anonyme v. Northlake Marketing and Supply, Inc.* 45 F.3d 1550 (Fed. Cir. 1995). Fisher does not teach or suggest that MDA-9 expression is altered in drug resistant cells. Fisher does not teach or suggest that compounds that alter MDA-9 expression are candidate modulators of drug resistance. Fisher does not teach or disclose a step of “identifying the compound as a candidate modulator of drug resistance in the cell if the level of expression of MDA-9 in the cell in the presence of the test compound differs from the level of expression of MDA-9 in the cell in the absence of the test compound.” Yet this step is required by claim 1 and the claims that depend from claim 1. Accordingly, since Fisher does not disclose every step of the claimed method, it cannot anticipate claim 1 or any of the claims that depend from claim 1.

Applicant : Mark Williamso
Serial No. : 09/531,369
Filed : March 21, 2000
Page : 6

Applicant's Docket No.: 07334-122001

for identifying candidate compounds that would be screened in a non-human model (steps d-f of claim 3. In claim 3 the ultimate determination that a compound is a modulator of drug resistance is not based on simply determining whether the compound binds MDA-9, rather it depends on determining whether the selected MDA-9-binding compound alters drug resistance of cells in a non-human mammal. Thus, the present claims are enabled, and Applicant requests that this rejection be withdrawn.

Conclusion

Applicant asks that all claims be allowed. Attached is a version with markings to show changes made in this amendment.

Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: June 13, 2002

for Anita L. Meiklejohn, Ph.D. 47,443
Reg. No. 35,283

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Applicant : Mark Williamson
Serial No. : 09/531,369
Filed : March 21, 2000
Page : 7

Applicant's Docket No.: 07334-122001

Version with markings to show changes made

In the claims:

Claim 22 has been amended as follows:

22. (amended) The method of claim 1 wherein the level of expression of [MDA-0]
MDA-9 is determined by measuring the level of MDA-9 protein.